

REMARKS

This paper is filed as a response to the Examiner's Office Action of May 30, 2003.

Original claims 1 through 35 are pending in the instant application. Claims 1, 12, 23, and 26-35 are rejected under 35 U.S.C. §102(b) as being anticipated by Suzuki et al. (U.S. Patent No. 4,970,546); claims 2, 5-11, 13, 16-22, and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki et al.; and claims 3-4, 14-15, and 24-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki et al. in view of Johnson et al. (U.S. Patent No. 5,969,805). Applicant respectfully traverses these rejections.

The Rejection of the Claims Under §102(b) is Overcome

Claims 1, 12, 23 and 26-35 are rejected under 35 U.S.C. §102(b) as anticipated by Suzuki et al. (U.S. Patent No. 4,970,546). MPEP §2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained...in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Specifically as to independent claims 1, 12, 23, and 31, and contrary to the Examiner's statements to the effect that all elements and limitations of claim 1, from which claims 2-11 depend, claim 12, from which claims 13-22 depend, claim 23, from which claims 24-30 depend, and claim 31, from which claims 32-35 depend, are disclosed in the Suzuki et al. reference, *a cut-off switch adapted to cut off energy from the energy source after a predetermined pulse light integrated intensity level*, as expressed in claims 1-22, or *a trigger circuit adapted to cut off power from the power source to the pulse light after a predetermined integrated intensity of light is detected*, as expressed in claims 23-30, or *cutting off power to the light source when the stored desired light intensity value and the detected light intensity value are substantially the same*, as expressed in claims 23-30, or *disconnecting the power to the light source when the integrated light intensity value and the predetermined light intensity value are*

substantially the same, as expressed in claims 31-35, are clearly not disclosed as expressed in Applicant's claims. Therefore, the rejection is unsupported by the art and should be withdrawn.

The Examiner states, with respect to Applicant's claims 1 and 12, that in the Suzuki et al. reference the "[m]ain control system 8 sends start and stop signals to a trigger circuit 9 for cutting off the pulse light source *in response to* the integrated intensity signals. (Office Action dated May 30, 2003, pg. 2, emphasis added). In response, Applicant points out that Suzuki et al. does not disclose that the main control system 8 sends start and stop signals to a trigger circuit 9 *in response to* receipt of an integrated signal value. Rather, Suzuki et al. states that "[t]he integrated value is supplied to a main control system 8 for exposure control." (Suzuki et al., Col. 4, lines 45-46). This "exposure control" is what the Suzuki et al. disclosure consists of, and is what the main control system directs, by sending instructions to high-speed attenuator 11 and low-speed attenuator 13 (Suzuki et al., Col. 6, lines 48-50). The main control system 8 of Suzuki et al. also sends oscillation start and end signals to the trigger control unit 9, but does not disclose that it does so *in response to* any signal.

Suzuki et al. does not disclose, or even contemplate, cutting off energy to a pulse light source in response to detecting a predetermined integrated intensity. In fact, Suzuki et al. admits, and assumes as given, that typical pulse light intensities fluctuate by $\pm 10\%$. (See Suzuki et al., Col. 7, lines 42-44). This problem of the fluctuation of pulse light intensities is what the present application addresses by cutting off the energy source at an appropriate time. It is clear from a reading of the Suzuki et al. disclosure that Suzuki et al. is directed to smoothing so-called "speckle fringes" and does so by controlling a pair of attenuators (exposure control).

Claims 2-11 are dependent upon independent claim 1 and are thus patentable for the same reasons given above with respect to claim 1 and more so since they add additional limitations.

Claims 13-22 depend upon independent claim 12 and are thus patentable for the same reasons given above with respect to claim 1 and more so since they add additional limitations.

Claims 26-30 are dependent upon currently amended independent claim 23 and are thus patentable for the same reasons given with respect to currently amended claim 23, and more so, since they add additional limitations.

Claims 32-35 are dependent upon currently amended independent claim 31 and are thus patentable for the same reasons given with respect to currently amended claim 31, and more so, since they add additional limitations.

The Rejection of the Claims Under §103 is Overcome

Claims 2, 5-11, 13, 16-22, and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki, et al. (U.S. Patent No. 4,970,546). Claims 2, 5-11, 13, 16-22, and 32 are all dependent claims. None of the independent claims (claims 1, 12, 23, and 35) have been rejected under 35 U.S.C. §103(a). MPEP§2143.03 provides: "If an independent claim is nonobvious under 35 U.S.C. 103(a), then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." Claims 2 and 5-11 depend on independent claim 1. Claims 13 and 16-22 depend on independent claim 12. Claim 32 depends on independent claim 31. Therefore, dependent claims 2, 5-11, 13, 16-22, and 32 are non-obvious.

"During patent examination the PTO bears the initial burden of presenting a prima facie case of unpatentability. ... If the PTO fails to meet this burden, then the applicant is entitled to a patent." *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002). MPEP §2142 provides:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. ... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of non-obviousness.* (Emphasis added.)

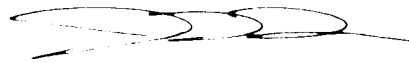
The PTO has not met its burden of presenting a prima facie case of nonobviousness, therefore, the applicant respectfully requests that the rejection of claims 2, 5-11, 16-22, and 32 under 35 U.S.C. §103(a) be withdrawn.

Conclusion

If the Examiner believes a telephone conference with Applicant's attorney would expedite or conclude prosecution of this application, he is cordially invited to contact Applicant's attorney by telephone at the below-listed number.

In summary, Applicant respectfully submits that claims 1-35, as originally submitted and as currently amended, are clearly allowable for the reasons stated herein and therefore request such allowance.

Respectfully submitted,



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